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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,898

04/11/2005

Alain Durand

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EXAMINER

ABYANEH, ALI S

ART UNIT

PAPER NUMBER

2137

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,898	Applicant(s) DURAND ET AL.	
	Examiner ALI S. ABYANEH	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04-11-2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-10 are presented for examination.

Information Disclosure Statement PTO-1449

2. The Information Disclosure Statement submitted by applicant on 04-11-2005 has been considered. Please see attached PTO-1449.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 1 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 and 10 call for a device that does not include any hardware. Claim 1 includes an exportation table (CET), the exportation table (CET) as specification page 4, lines 25-28 and claim 3 suggest, is a software. As such, the claims do not fall within any of the four statutory classes.

Claim Objection

5. Claim 1-10 are objected to because of the following informalities:

Claims recite the word "Device" at the beginning of the claims. Examiner suggests inserting an --A-- before "device" in independent claims 1 and 10 and inserting word --the--before "Device" in depending claims.

In claim 6, after "claim 5," insert --wherein--.

Claim 8 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 8 and 9 are method claims and are dependent on claim 1 and 7 which are device claim.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, the term "**intended** to be used" is a relative term which renders the claim indefinite. The term "intended" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsushima et al. (US Publication No.2002/0161571).

Regarding claim 1

Matsushima teaches a device for preventing illegal exportation of a content protected by a global copy protection system to a local copy protection system, wherein each content liable to be exported contains a unique identifier and wherein the device comprises an exportation table for storing unique identifiers of all contents that have already been exported through said device (paragraph [0059]).

Regarding claim 2

Matsushima furthermore teaches a device, wherein the unique identifier is contained in a part of the content protected by encryption or authentication and wherein the device further comprises means for extracting said unique identifier from the content (paragraph [0055]).

Regarding claim 3

Matsushima furthermore teaches a device, wherein the exportation table is stored in a secure memory of the device (paragraph [0113]).

Regarding claim 4

Matsushima furthermore teaches a device, wherein the exportation table is stored in an encrypted or authenticated form in a conventional memory of the device and wherein the encryption key or authentication key used to encrypt or authenticate the exportation table is stored in a secure memory (paragraph [0113]).

Regarding claim 5

Matsushima furthermore teaches a device intended to be used in a local network protected by a global copy protection system, wherein there are a limited number of such devices in the network (paragraph [0177]).

Regarding claim 6

Matsushima furthermore teaches a device, there is only one such device in the network (paragraph [0177]).

Regarding claim 7

Matsushima furthermore teaches a device, wherein the exportation table stored in said device further contains, for each unique identifier a counter of the number of

exportations of the content associated with said unique identifier, this counter being incremented each time an exportation is made through said device (paragraph [0179]-[0180]).

Regarding claim 8

Matsushima furthermore teaches a device wherein, if the copy is to be made for a local copy protection system, in: checking whether the unique identifier of said content is contained in the exportation table of said device; and should said checking be positive, then preventing the recording; and should said checking be negative, then recording the content and storing said unique identifier in said exportation table (paragraph [0180]).

Regarding claim 9

Matsushima furthermore teaches a device wherein, if the copy is to be made for a local copy protection system, in: (a) checking whether the unique identifier of said content is contained in the exportation table of said device; and should said checking of step (a) be positive, then (b) checking whether a predetermined maximum number of authorized copies has been reached by the counter associated with the unique identifier, and in case the maximum number of copies has been reached, then preventing the recording; and in case the maximum number of copies has not been reached, then incrementing the counter and recording the content; and should said

checking of step (a) be negative, then recording the content and storing said unique identifier (CUI) in said exportation table (paragraph [0095]-[0198]).

Regarding claim 10

Matsushima teaches a device e adapted to be linked to a local network protected by a global copy protection system and to convert a content it receives into a content protected by said global copy protection system, wherein said device is furthermore adapted to generate a unique identifier for each content it converts, the unique identifier being inserted in a part of the content protected by encryption or by authentication (paragraph [0055]).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abyaneh whose telephone number is (571) 272-7961. The examiner can normally be reached on Monday-Friday from (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone numbers for the organization where this application or proceeding is assigned as (571) 273-8300 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ali S Abyaneh/
Examiner, Art Unit 2137
06-05-2008

/Emmanuel L. Moise/
Supervisory Patent
Examiner, Art Unit 2137